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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,826	10/30/2001	John R. Geary	P00078US1A (P271)	1042

7590 10/23/2003  
Chief Intellectual Property Counsel  
Bridgestone/Firestone, Inc.  
1200 Firestone Parkway  
Akron, OH 44317-0001

EXAMINER
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VO. HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/020,826

Applicant(s)

GEARY ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-13 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 8,11-13 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 21 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

1. Claims 3, 4, 9, 10, 14-19 have been canceled in the amendment received on 07/28/2003.

***Election/Restrictions***

2. Newly submitted claim 22 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1, 2, 5-7, 20, and 21 drawn to a composite board, classified in class 428, subclass 317.9.

- II. Claims 8, 11-13, and 22 drawn to a method of re-roofing a roof, classified in class 264, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a carpet padding (see US 5,846,461) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8, 11-13, and 22

are withdrawn from consideration as being directed to a non-elected invention.

See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim objections***

3. Claim 20 is objected because it depends from claim 14 which has been canceled in the amendment received on 07/28/2003.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al (US 5,846,461) substantially as set forth in the office Action mailed on 04/24/2003.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton et al (US 5,735,092) in view of Frisch et al (US 5,091,436). Clayton

teaches a composite roofing member including a foam core 11 selected from the group consisting of polyisocyanurate, polyurethane and mixtures thereof; a facer 13 applied to one surface of the foam core and made of a reinforced polymer material; and gypsum board 14 applied to the opposite surface of the foam core (figure 1). Clayton further discloses a weather protective layer being applied to the recovery board (column 6, lines 10-15). Clayton discloses the polyisocyanurate foam having an iso index above 200 (column 5, line 7). Clayton is silent as to a foam core having been reinforced with a filler material. Frisch teaches a reinforced foam composite comprising a rigid polyurethane foam core reinforced with glass fiber (column 5, lines 44-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the reinforcing fabric into the foam core of Clayton motivated by the desire to increase the strength of the composite roofing member.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton et al (US 5,735,092) in view of Frisch et al (US 5,091,436) as evidenced by Rosato et al (US 4,388,366). Clayton as modified by Frisch does not specifically disclose the composite board comprising a foam core being sandwiched between the two facers. The Rosato reference relied on as evidence of the state of the art teaches an insulation board for use in roofing having a foam core sandwiched between the two facers to provide the foam core with improved dimensional stability (figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a facer to both sides of

the foam core of Clayton as modified by Frisch motivated by the desire to provide the foam core with improved dimensional stability.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 2, and 5-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,735,092 in view of Frisch et al (US 5,091,436). See discussion in the paragraph no. 7.
11. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,735,092 in view of Frisch et al (US 5,091,436) as evidenced by Rosato et al (US 4,388,366). See discussion in the paragraph no. 8.

***Response to arguments***

12. The specification objections and the 112 claim rejections have been overcome by the present amendment and response.
13. The 102 art rejections over Frisch, the 103 art rejections over Collins in view of Ghobary and the art rejections over Clayton in view of Hunter, Jr. have been overcome by the present amendment and response.
14. The 102 art rejections over Collins have been maintained for the following reasons. Applicants argue that the filled foam core of Collins is necessarily flexible to provide a soft cushion underlay for the carpet padding whereas Applicants' foam product is a rigid foam. However, nothing in claim 1 is specific about the rigid of the foam to provide any distinction over the prior art such as foam density or iso index. The examiner suggests the limitations from claim 2 should be included in claim 1 in order to overcome the anticipation.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 10/020,826  
Art Unit: 1771

Page 7

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*